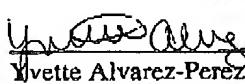


FEB 17 2004

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Yvette Alvarez-Perez

2/17/04  
Date

OFFICIAL

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/055,822  
Applicant : Volkmar Schwitzky et al.  
Filed : January 23, 2002  
Title : FINISHING PROCESS  
Examiner : Parker, Frederick J.  
Art Unit : 1762  
Attorney Docket No. : 103797-238-NP

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY TO ADVISORY ACTION**

Sir:

This is responsive to the Advisory Action mailed on December 15, 2003 with the Decision on the Petition to Revive the Application. This Reply to Advisory Action and the Reply to Final Office Action filed on Nov. 13, 2003 serve as the submission required for the Request for Continued Examination (RCE), which is being filed concurrently under 37 CFR 1.114. Applicants request entry of both replies and reconsideration of the above-identified patent applications in view of the amendments and remarks in the replies.

In the Advisory Action, the Examiner contends,

"[m]erely specifying "watermark" for "distinguishing feature" does not patentably distinguish over the prior art because the combination of Weitzberg in view of Shenton already

LIBNY/4280499.1

provides a coating process comprising applying a watermark to a printed security substrate which is subsequently at least partially lacquered for the same reasons, namely providing tamperproof security seals. The proposed amendment therefore fails to overcome the prior art rejections."

The present invention as defined in claim 1, as amended in the Reply to the Final Office Action, relates to a method for finishing a printed security sheet carrying at least one watermark, comprising: (1) partially coating the printed security sheet in one step with a layer of lacquer to the at least one watermark such that the at least one watermark is emphasized by increasing the transparency thereof; and (2) lacquering the printed security sheet in another step over its whole surface to increase the durability of the security sheet. The Applicants have found that coating a watermark with a layer of lacquer increases the transparency of the watermark and therefore, the watermark is more clearly visible, due to the increased difference in transparency of the watermark and its surrounding area, so that the watermark can be recognized clearly even without holding the sheet against a source of light. The purpose of the claimed invention is not tamperproofing the security seals as contended by the Examiner.

Weitzberg teaches a tamper-proof identification document comprising a base card attached to a photographic layer comprising both a picture section and a data text section. A significant marking extends over both the picture and text sections. The photographic layer is overlaid with a transparent security coating layer. In column 2, lines 38-41, Weitzberg describes that the specific marking is preferably a water-marking. However, Weitzberg does not teach or suggest the use of a watermark which is partially coated and emphasized with lacquer prior to coating the protective transparent security coating.

Shenton teaches a method of providing a security device on a substrate comprising embossing at least one transitory image, and a linear area which is visible when the device is examined from substantially all viewing angles. Shenton further teaches that the substrate printed with metallic inks could be overprinted with a tinting lacquer to provide colored metallic effects. Shenton nowhere mentions a watermark, much less partial coating a watermark to emphasize the watermark.

Therefore, the combination of Weitzberg and Shenton still fails to teach or suggest the use of a watermark which is partially coated and emphasized with lacquer prior to coating the protective transparent coating. The claimed invention is not obvious over Weitzberg in view of Shenton. The applicants submit that the claim rejections under 35 U.S.C. § 103(a) are overcome and withdrawal thereof is respectfully requested.

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicant,



Eva Tan (Reg. No. 46,406)  
GOODWIN PROCTER LLP  
103 Eisenhower Parkway  
Roseland, NJ 07068  
(973) 992-1990 Ext. 7904

PTO/SB/30 (08-03)

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# Request For Continued Examination (RCE) Transmittal

Address to:  
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Alexandria, VA 22313-1450

Application Number	10/055,822
Filing Date	January 23, 2002
First Named Inventor	Volkmar Schwitzky, et al.
Art Unit	1762
Examiner Name	Parker, Frederick J.
Attorney Docket Number	103797-238-NP

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- ii. ☒ Other Reply to Final Office Action filed November 13, 2003.
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/ Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other \_\_\_\_\_

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

## 3. Fees

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed. The Director is hereby authorized to charge the following fees, or credit any overpayments, to
- a. ☒ Deposit Account No. 06-0923

- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_

- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	Eva Tan	Registration No. (Attorney/Agent)	46,406
Signature	<i>Eva Tan</i>	Date	February 17, 2004

## CERTIFICATE OF MAILING OR TRANSMISSION

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Name (Print/Type)	Yvette Alvarez-Perez	Date	February 17, 2004
Signature	<i>Yvette Alvarez-Perez</i>		

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PTO/SB/17 (10-03)

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# FEE TRANSMITTAL

## for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT

(\$ 770.00)

## Complete if Known

Application Number 10/055,822  
 Filing Date January 23, 2002  
 First Named Inventor Volkmar Schwitzky, et al.  
 Examiner Name Parker, Frederick J.  
 Art Unit 1762  
 Attorney Docket No. 103797-238-NP

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
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 Deposit  
 Account  
 Number  
 Deposit  
 Account  
 Name

06-0923

Goodwin Procter LLP

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## FEE CALCULATION

## 1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 285	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 180	2005 80	Provisional filing fee	

SUBTOTAL (1) (\$)

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent	-20** =	X	
Multiple Dependent	-3** =	X	

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

## 3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	2053 130	Non-English specification	
1812 2,520	2812 2,520	For filing a request for ex parte reexamination	
1804 920*	2804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	2805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	2451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	2460 130	Petitions to the Commissioner	
1807 50	2807 50	Processing fee under 37 CFR 1.17(q)	
1808 180	2808 180	Submission of Information Disclosure Stmt	
8021 40	28021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	770
1802 900	2802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 770.00)

## SUBMITTED BY

Name (Print/Type) Eva Tan

Signature

Registration No. (Attorney/Agent)

46,406

(Complete if applicable)

Telephone 973-992-1990

Date

February 17, 2004

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**FEE TRANSMITTAL**  
**for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ 770.00)**Complete if Known**

Application Number	10/055,822
Filing Date	January 23, 2002
First Named Inventor	Volkmar Schwitzky, et al.
Examiner Name	Parker, Frederick J.
Art Unit	1762
Attorney Docket No.	103797-238-NP

**METHOD OF PAYMENT (check all that apply)**☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit Account:Deposit Account Number  
06-0923Deposit Account Name  
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☒ Charge fee(s) indicated below ☒ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>			<b>(\$)</b>

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims	Extra Claims	Fee from below	Fee Paid
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Multiple Dependent	-3** =	X	

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	88	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	88	2204	43	** Reissue Independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

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**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 60	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
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1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

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**SUBTOTAL (3)** (\$ 770.00)**SUBMITTED BY**

Name (Print/Type)

Eva Tan

Registration No.  
(Attorney/Agent)

46,406

(Complete if applicable)

Telephone 973-992-1990

Signature

Date

February 17, 2004

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